

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

K.MIZRA LLC

Plaintiff,

v.

CA, INC.,

Defendant.

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Case No. 2:21-cv-00247-JRG

(Lead Case)

K.MIZRA LLC

Plaintiff,

v.

FORESCOUT, INC.,

Defendant.

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Case No. 2:21-cv-00248-JRG

(Member Case)

K.MIZRA LLC

Plaintiff,

v.

FORTINET, INC.,

Defendant.

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Case No. 2:21-cv-00249-JRG

(De-consolidated)

K.MIZRA LLC

Plaintiff,

v.

HEWLETT PACKARD ENTERPRISE
COMPANY and ARUBA NETWORKS, LLC,

Defendants.

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Case No. 2:21-cv-00305-JRG

(Non-consolidated)

JOINT STATUS REPORT CONCERNING *INTER PARTES* REVIEWS

Pursuant to this Court's Orders,¹ Plaintiff K.Mizra LLC ("K.Mizra") and Defendants Forescout, Inc. ("Forescout"); Fortinet, Inc. ("Fortinet"); and Hewlett Packard Enterprise Company and Aruba Networks, LLC ("HPE") hereby submit a Joint Status Report on the status of *inter partes* review proceedings related to this case, all of which have now concluded before the Patent Trial and Appeal Board.

Final decisions have now issued by the USPTO Patent Trial and Appeal Board as to all three of the patents at issue in these cases. As detailed below, the PTAB upheld the patentability of the asserted claims of U.S. Patent No. 8,234,705 (the '705 Patent) and U.S. Patent No. 9,516,048 (the '048 Patent), and the Board found the asserted claims of U.S. Patent No. 8,965,892 (the '892 Patent) unpatentable. The '075 and '048 Patents are asserted against Forescout, Fortinet, and HPE, and the '892 Patent is asserted only against Fortinet.

I. The '892 Patent

As noted in the parties' prior Joint Status Report of September 26, 2022, regarding U.S. Patent No. 8,965,892 (asserted against Defendant Fortinet only), the PTAB instituted an IPR (Case No. IPR2021-00594, Paper 10) on September 24, 2021, on claims 1-7, and 9-18. The PTAB entered its Final Written Decision on August 12, 2022 (Paper 35), wherein the Board determined that claims 1-7 and 9-18 are unpatentable. On September 14, 2022, K.Mizra appealed to the U.S. Court of Appeals for the Federal Circuit from the PTAB's Final Written Decision (Paper 36).

¹ No. 2:21-cv-00247-JRG, ECF No. 79 (Dec. 2, 2021) (Forescout); No. 2:21-cv-00249-JRG, ECF No. 15 (Nov. 22, 2021) (Fortinet); No. 33, ECF No. 2:21-cv-00305-JRG (Nov. 17, 2021) (HPE).

II. The '705 Patent

As also noted in the parties' prior Joint Status Report of September 26, 2022, regarding U.S. Patent No. 8,234,705 (asserted against each of Forescout, Fortinet, and HPE), the PTAB instituted an IPR (Case No. IPR2021-00593, Paper 9) on September 24, 2021, on claims 1-3, 5-13, and 15-19. The PTAB entered its Final Written Decision on September 19, 2022 (Paper 41), that claims 1-3, 5-13, and 15-19 were not shown to be unpatentable. On September 27, 2022, petitioner Cisco Systems, Inc. appealed to the U.S. Court of Appeals for the Federal Circuit from the PTAB's Final Written Decision (Paper 42).

III. The '048 Patent

Regarding U.S. Patent No. 9,516,048 (also asserted against each of Forescout, Fortinet, and HPE), on October 31, 2022, the PTAB issued its Decision Denying Institution of *Inter Partes* Review (Paper 14).

IV. Status of the Cases When Stayed

The parties further write to briefly apprise the Court of the status of significant case events relating to each of the constituent matters captioned above, so that the Court may take such into account for go-forward scheduling purposes:

1. **-247 Case:** On August 24, 2021, K.Mizra's formerly asserted case against Defendant CA, Inc., was consolidated for pretrial purposes with K.Mizra's claims against Forescout and Fortinet in lead case 2:21-cv-00247-JRG. *See* Case No. 2:21-cv-00247-JRG, ECF No. 15. K.Mizra moved to dismiss its case against CA, Inc. (though not against consolidated Defendants Forescout and Fortinet) on October 27, 2021, which motion the Court granted on November 2, 2021. *See id.* ECF Nos. 60, 67. Thereafter, K.Mizra's cases against Forescout and Fortinet were consolidated for pretrial purposes

- in Lead Case No. 2:21-cv-247-JRG, until the stay against Fortinet was entered in November 2021 (*see* No. 3 *infra*).
2. **-248 Case:** K.Mizra's case against Forescout was stayed pending resolution of IPR per the Court's December 2, 2021 order granting K.Mizra and Forescout's joint motion. *See* No. 2:21-cv-00248-JRG, ECF Nos. 78-79.
- a. As of the December 2, 2021 stay:
 - i. The parties had filed, and the Court had entered, a Docket Control Order; Discovery Order; and Protective Order. *See* ECF Nos. 52 (DCO), 53, 58.
 - ii. K.Mizra had served its preliminary infringement contentions; Forescout had not yet served its preliminary invalidity contentions; and no events relating to claim construction had yet occurred. *See* No. 2:21-cv-00247-JRG, DCO at 4.
 - b. In addition, Forescout had filed both a Motion to Transfer Venue Pursuant to 28 U.S.C. § 1404(a) and a Motion to Dismiss K.Mizra's Amended Complaint. *See* No. 2:21-cv-00247-JRG, ECF Nos. 23 (Sept. 10, 2021), 44 (Oct. 7, 2021). Briefing was closed as to both motions before the case was stayed (*see* ECF Nos. 75 (Nov. 19, 2021) (motion to transfer), 68 (Nov. 5, 2021) (motion to dismiss)), but the Court had not yet ruled on either motion.
3. **-249 Case:** K.Mizra's case against Fortinet was de-consolidated from the -247 Lead Case and stayed pending resolution of IPR per the Court's November 22, 2021 order granting K.Mizra and Fortinet's joint motion. *See* No. 2:21-cv-00247-JRG, ECF Nos. 73, 75; No. 2:21-cv-00249-JRG, ECF No. 15.

- a. As of the November 22, 2021 stay:
- i. The parties had filed, and the Court had entered, a Docket Control Order; Discovery Order; and Protective Order. *See* No. 2:21-cv-00247-JRG, ECF Nos. 52 (DCO), 53, 58.
 - ii. K.Mizra had served its preliminary infringement contentions; Fortinet had not yet served its preliminary invalidity contentions; and no events relating to claim construction had yet occurred. *See* No. 2:21-cv-00247-JRG, DCO at 4.
4. **-305 Case:** K.Mizra's case against HPE was initiated approximately one month later than the three cases above (filed August 9, 2021, as compared to July 8, 2021, for the three cases above). K.Mizra's claims against HPE were stayed pending resolution of IPR per the Court's November 17, 2021 order granting K.Mizra and HPE's joint motion. *See* Nos. 29, 33. As of the November 17, 2021 stay, the parties had not yet appeared for initial scheduling conference. K.Mizra had served its preliminary infringement contentions; HPE had not yet served its preliminary invalidity contentions; and no events relating to claim construction had yet occurred.

Respectfully submitted,

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Dated: November 8, 2022

CERTIFICATE OF SERVICE

I hereby certify that on the 8th day of November 2022, I electronically filed the foregoing with the clerk of Court using the CM/ECF system, which will send notification of such filing to all counsel of record.

By: /s/ Joseph M. Abraham
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